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09/410,162 09/30/99 KLOSOWSKI

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EXAMINER

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ART UNIT	PAPER NUMBER

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 11

Application Number: 09/410,162
Filing Date: September 30, 1999
Appellant(s): KLOSOWSKI ET AL.

Timothy J. Troy
For Appellant

MAILED

JUL 10 2001

GROUP 1700

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 6/8/2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 51, 54 and 55 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

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(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,736,251

Pinchuk

4-1998

Leidheiser, H. Jr. et al. "Corrosion Behavior of Steel Pre-treated with Silanes". Corrosion (Houston) (1987), 43(6), pp 382-387.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 51 and 54-55 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 7, filed 11/13/2000.

Claims 51, 54 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinchuk (5736251). '251 teaches forming a coating on an elastomeric (i.e. organic) article with a silane such as methyltriacetoxysilane (5:64) that is cured into a homopolymer or copolymer (6:6-19). '251 fails to teach that the coating preserves the substrate, but such an effect would be inherent to the silanes used. Regarding applicant's argument in the 11/3/2000 amendment that the silane is a coating material and not an impregnant, the art does not recognize any distinction between coating and impregnating (In re Marra 141 USPQ 221).

Claims 51, 54 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leidheiser et al. Leidheiser teaches the protection of an inorganic material such as steel panels with polymerized methyltriacetoxysilane (see entire article). Leidheiser fails to teach that the coating preserves the substrate, but protection against corrosion is a type of preservation. Regarding applicant's argument in the 11/3/2000 amendment that the silane is a coating material and not an impregnant, the art does not recognize any distinction between coating and impregnating (In re Marra 141 USPQ 221).

(11) Response to Argument

The applicant has argued in the Pinchuk (5736251) rejection that "...the coatings are intended to affect only the surface of the article...". In fact, Pinchuk discloses that the silane "...forms a highly cross-linked three dimensional silicone matrix on the surface of the article, as well as a crosslinked interpenetrating network within the substrate..." (5:5-8). In Example 7, it was observed that methyltriacetoxysilane had "...penetrated the bulk of the balloon catheter substrate and was not only a surface coating...". The applicant is simply not correct when he says that Pinchuk intends the silane to affect only the surface of the substrate.

The applicant has also argued in the Pinchuk (5736251) rejection that "...in the art of the preservation of materials, there is clearly an art-recognized distinction between coating and impregnating. Many specimens like any animal or human specimen will stay preserved for tens or maybe hundreds of years if all the cells are reacted. This means all the cells on the surface and in the interior. With material that is subject to oxidation or bacterial growth, if this total

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impregnation is not conducted, within days or weeks decay or purification (sic) will set in..." and "...if the internal cells were not totally filled with the preserving medium there would be shrinkage of the specimen..." and "...the preservation techniques described in this invention refer to total impregnation and reaction in the cells..."

However, Claims 51 and 54-55 do not claim "cells", or "total impregnation and reaction in the cells", or that internal cells are totally filled with the preserving medium, or that "all the cells are reacted", or that oxidation or bacterial growth are prevented on the material that is impregnated.

The applicant further argues that in the Pinchuk reference "...the item to be coated is immersed in a coating solution for a period of about 2 to 10 minutes and is then removed from the solution and immediately placed in an oven for curing. ...immersing a specimen in a solution for 2 to 10 minutes would clearly be insufficient to preserve the material...". However, Claims 51 and 54-55 do not claim an impregnation time, and therefore claims 51 and 54-55 do not distinguish over Pinchuk.

The applicant has also argued that the In re Marra case is distinguishable from the case at hand because the invention and references cited in In re Marra both related to methods of coating paper, in contrast to the claimed invention which relates to a method of preserving organic or inorganic materials and the Pinchuk reference that relates to surface coatings. However, both the claimed invention and the Pinchuk reference relate to the application of silanes to an organic

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material. In re Marra says that in the application of a composition to a material, coating and impregnating are not distinguishable. And as has been described above, the Pinchuk process does result in both a surface coating as well as a penetration of the silane into the substrate.

The applicant has argued in the Leidheiser et al rejection that "...Leidheiser discloses that steel panels were coated with ten different silanes by brushing the silane...on the surface...brushing the silanes onto organic or inorganic materials would not in fact preserve them...". However, that is exactly what occurs when the methylacetoxysilane is applied to the steel. Leidheiser et al state that "The data show that steel substrates treated with MTS (methyltriacetoxysilane), PTSF, and GPTS provide corrosion protection and cathodic delamination resistance." (page 385) . This is preservation.

The applicant has also argued that the In re Marra case is distinguishable from the instant case, because the invention and references cited in In re Marra both related to methods of coating paper, in contrast to the claimed invention that relates to a method of preserving organic or inorganic materials and Leidheiser et al that relates to coating steel panels. However, both the claimed invention and the Leidheiser reference relate to the application of silanes to an inorganic material. In re Marra says that in the application of a composition to a material, coating and impregnating are not distinguishable.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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July 5, 2001

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